



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/419,788 10/18/99 FISCHER

R 0147-0189P

EXAMINER

HM12/1019
BIRCH STEWART KOLASCH & BIRCH LLP
P O BOX 747
FALLS CHURCH VA 22040-0747

ARTUR MANN, J. PAPER NUMBER

DATE MAILED: 1655

14
10/19/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/419,788

Applicant(s)

FISCHER ET AL.

Examiner

Juliet C Einsmann

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1655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 18-42 is/are pending in the application.
- 4a) Of the above claim(s) 21-28 and 30-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-14, 18-20, 29, and 36-42 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

This action is in response to Applicant's correspondence filed 8/8/01. Applicant's election of group II, claims 1-14, 18-20, 29, and 36-42 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Thus, claims 21-28 and 30-35 are withdrawn from prosecution. Upon further consideration, the elected claims are subject to further restriction as designated below.

Election/Restrictions

Prior to setting forth the restriction requirement, it is pointed out that the claims are drawn to patentably distinct methods and products. The methods and products rely on binding domains to a number of different plant pathogens which differ in structure and modes of action to such an extent and require non-coextensive searches to such an extent that they are considered separately patentable. Therefore the restriction will be set forth for each of the various groups, irrespective of the format of the claims, because these are not proper species.

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - A. Claims 1-14, 18-20, 29, 36, and 38-42, drawn to fusion proteins comprising an antibody or binding site that specifically recognizes an epitope of a plant virus, classified in class 424, subclass 147.1.
 - B. Claims 1-14, 18-20, 29, 36, and 38-42, drawn to fusion proteins comprising an antibody or binding site that specifically recognizes an epitope of a bacterial plant pathogen, classified in class 424, subclass 150.1.

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- C. Claims 1-14, 18-20, 29, 36, and 38-42, drawn to fusion proteins comprising an antibody or binding site that specifically recognizes an epitope of a fungal plant pathogen, classified in class 424, subclass 152.1.
- D. Claims 1-14, 18-20, 29, 36, and 38-42, drawn to fusion proteins comprising an antibody or binding site that specifically recognizes an epitope of a nematode plant pathogen, classified in class 424, subclass 151.1.
- E. Claims 1-14, 18-20, 29, 36, and 38-42, drawn to fusion proteins comprising an antibody or binding site that specifically recognizes an epitope of a insect plant pathogen, classified in class 424, subclass 151.1.
- F. Claims 1-14, 18-20, 29, 36, and 38-42, drawn to fusion proteins comprising an antibody or binding site that specifically recognizes an epitope of a mycoplasma plant pathogen, classified in class 424, subclass 152.1.
- G. Claim 37, drawn to fusion proteins comprising an antibody or binding site that specifically recognizes an epitope of a plant virus, classified in class 424, subclass 147.1.
- H. Claim 37, drawn to fusion proteins comprising an antibody or binding site that specifically recognizes an epitope of a bacterial plant pathogen, classified in class 424, subclass 150.1.
- I. Claim 37, drawn to fusion proteins comprising an antibody or binding site that specifically recognizes an epitope of a fungal plant pathogen, classified in class 424, subclass 152.1.

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- J. Claim 37, drawn to fusion proteins comprising an antibody or binding site that specifically recognizes an epitope of a nematode plant pathogen, classified in class 424, subclass 151.1.
- K. Claim 37, drawn to fusion proteins comprising an antibody or binding site that specifically recognizes an epitope of a insect plant pathogen, classified in class 424, subclass 151.1.
- L. Claim 37, drawn to fusion proteins comprising an antibody or binding site that specifically recognizes an epitope of a mycoplasma plant pathogen, classified in class 424, subclass 152.1.

The inventions are distinct, each from the other because of the following reasons:

- 2. The products of groups A-F are distinct in structure, function and mode of action. The methods of groups G-L utilize the distinct products of groups A-F. These compounds do not share a substantial structural feature essential to a common utility. In addition, a person of ordinary skill in the art would not envision one in view of the other. Thus, they are separate and distinct.
- 3. Inventions A-F are related to inventions G-L as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the fusion proteins of inventions A-F can be used in other methodologies, such as to purify and detect antigens of interest.

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4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as demonstrated by their different classification and recognized divergent subject matter and because inventions A-L require different searches that are not coextensive, examination of these claims would pose a serious burden on the examiner and therefore restriction for examination purposes as indicated is proper.

5. This application contains claims directed to the following patentably distinct species of the claimed invention:

The claims recite a number of binding domains including (a) antibodies, (b) T-cell receptors, (c) pathogen specific receptors, and (d) peptide specific epitopes of a pathogen. Applicant is required to elect a single disclosed species for prosecution. If (b), (c), or (d) is elected, claim 6 will be withdrawn from prosecution. These species are distinct because they have different structures, functions and physiochemical properties.

The claims further recite a number of membrane localisation sequences which are each distinct in structure, function, and physiochemical properties. Applicant is required to elect one of the localisation sequences from: (a) human T cell receptor transmembrane domains (b) any other member of the immunoglobulin superfamily, (b) GPI anchors, (c) KAR1, (d) middle-T antigen, (e) cytochrome b5 or (f) syn 1. Applicant is required to elect a single disclosed species for prosecution.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).


7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

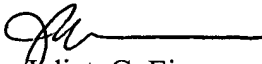
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Juliet C. Einsmann whose telephone number is (703) 306-5824. The examiner can normally be reached on Monday through Friday, from 9:00 AM until 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones can be reached on (703) 308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 and (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.


JEFFREY FREDMAN
PRIMARY EXAMINER


Juliet C. Einsmann
Examiner
Art Unit 1655

October 16, 2001